

REMARKS

In response to the Examiner's Office Action of November 17, 2003, Applicants have now made corrective amendments to the specification and corrective amendments to the drawings.

Further, Applicants have made amendments to the claims regarding the citation of certain informalities, such as inconsistent terminology, incorrect capitalization, indefiniteness and insufficient antecedent basis. This should now obviate objections under 35 USC §112.

A. The Examiner has rejected claims 1-3, 7-9, 11 and 12, under 35 USC 102(b) as being anticipated by the Seitz Reference "A", U.S. Patent 5,805,823. Additionally, while Examiner has not cited Applicants' Information Disclosure Statement which provided the KNAS (Kerberos Network Authentication Service), however, Examiner has still cited aspects of this document.

At this point, Applicants would traverse Examiner's contention that the Seitz patent, 5,805,823, anticipates Applicants' invention.

As seen in Examiner's paragraph 1 on page 4 of his Office Action, the Examiner has cited a series of items --- "a", "b", "c", "d". . ."g", "h", "i", "j", "k".

Here, Examiner has selected various bits and pieces of Applicants' claims and the Examiner has cited and pulled-up a variety of other elements from the Kerberos Network Authentication Service, in addition to certain aspect of the Seitz reference. Thus, the Examiner is trying to re-create Applicants' invention as stated in

these claims by picking and choosing bits and pieces from other references.

In a case reported in the Bureau of National Affairs Patent, Trademark & Copyright Journal, on page 109 of the issue dated December 10, 1992, the case of Price v. Code Alarm, Inc., which was decided on November 5, 1992, by the United States District Court of the Northern District of California --- here, it was indicated that combination claims are not invalid for obviousness merely because similar elements appear in separate prior art references. The court stated that one may not pick and choose among the individual elements of prior art references in order to re-create the basis of the invention. Further, the court declared:

A holding that combination claims are invalid based merely on finding similar elements in separate prior art patents would be "contrary to statute and could defeat the congressional purpose in enacting Title 35" . . . not only must the claimed combination be considered as a whole under the express mandate of USC 103, but the prior art references must also be considered in their entireties to determine whether they suggest the desirability of making the combination which Code-Alarm asserts renders claims 7 and 8 obvious. (underlines added).

However, while the above reference was applied to Article 103(a) obviousness situations, the similar situation will occur as indicated by the following reference regarding anticipation under Article 102.

In the case of Kalman v. Kimberly-Clark Corporation, 713 F.2d 760, 218 USPQ 781, 789 decided by the Federal Circuit in 1983, the following was indicated by the Court:

A party asserting that a patent claim is anticipated under 35 USC Article 102, must demonstrate among other things, identity of invention. Identity of invention is a question of fact, and one who seeks such a finding must show that each element of the claim in issue is found, either expressly described or under principles of inherency in a single prior-art reference, or that the claimed invention was previously known or embodied in a single prior-art device or practice. Preliminary to this determination, is construction of the claims to determine their meaning in light of the specification and prosecution history which construction is a matter of law for the Court.

In order to indicate that there is a relationship between anticipation and obviousness, Applicants would now cite the case of Jones v. Hardy, 220 USPQ 1021, 1025, decided by the Federal Circuit in 1984 where it was stated:

Though anticipation is the epitome of obviousness, they are separate and distinct concepts.

Then, further, Applicants would recite the case of Mendenhall v. Aztec Industries, Incorporated, 13 USPQ 2d 1913, 1928, decided in Tennessee in 1988, and affirmed by the Federal Circuit in 1989 at 13 USPQ 2d, p. 1956. The conclusion here was as follows:

When a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options disclosed by the reference, then the reference does not anticipate.

Then, in the case of Minnesota Mining and Manufacturing Company v. Johnson & Johnson Orthopaedics, Incorporated, decided by the Federal Circuit in 1992, and reported at 24 USPQ 2d pp. 1321, 1326, the following was stated:

A party asserting that a patent claim is anticipated under 35 USC Article 102 "must demonstrate . . . identity of invention".

Of course, in the above situation, there is no way that the Examiner can demonstrate any identity of invention as will be explicitly discussed and described in succeeding remarks herein.

Then, as a further note, in the case of Ultradent Products, Incorporated v. Life-Like Cosmetics, Incorporated, reported at 39 USPQ 2d, 1969 at p.1980, decided in Utah in 1996, the following would clearly indicate the situation as follows:

Any degree of physical difference, however slight, invalidates claims of anticipation.

B. Now, to cite some of the clauses involved when looking at claims 1-3, 7-9, 11 and 12, and the various cited elements "a", "b", "c" . . . "h", "i", "j", "k", --- at Examiner's element "b" regarding asynchronous authentication, where the Examiner cited the Seitz reference, column 19, line 23, et seq. Here, it should be noted that the only mention by Seitz is that an authentication protocol may be used, for example, Kerberos, DSA RSA, and the like.

But note here, Seitz has is no implementation or concept of implementation as is shown and indicated in Applicants' Figs. 15, 16, 17. There is no way that this statement of Seitz can be stretched or taught to teach Applicants' system. Further, there is nothing in the Kerberos Network Authentication Service which teaches or shows the elements involved in Applicants' Figs. 15, 16 and 17, and the description thereof.

The Examiner has cited several items, such as items "e", "g", "h", "i", "j", "k", to refer to terminology in the document of the Kerberos Network Authentication Service. These statements here do not in any fashion describe or teach the methodology and the inter-cooperating modules which are shown in Applicants' Figs. 15, 16 and 17. There is no way that the statements of Seitz and any statements made in the Kerberos Network Authentication Service document could show, teach or indicate the specific arrangements and functional operations of Applicants' Figs. 15, 16 and 17.

C. It will be of considerable benefit to look at the Seitz patent and compare it to the operations of Applicants' invention in order to see the considerable differences involved, so that any question of anticipation would be immediately obviated.

C1. It should be indicated that the Seitz reference in essence, works to "handle messages" (transfer data asynchronously) between Applications in the client-server network.

Quite differently, Applicants' system involves the handling of messages (data transfer asynchronously) between an application and a server in a client-server network. Note that this involves a considerable difference in the function and architectural arrangements involved.

Applicants' system is specific to data transfer between the client (and/or clients) to a server which involves a specialized Unisys Server operating within the Kerberos Realm, and this data transfer is done via an intermediary server designated as a Kerberos Server.

There is no such teaching in the Seitz reference, nor can Seitz be combined with the KNAS document to design or provide such a system.

C2. It will be seen that Seitz operates at a high level asynchronous message handling between clients.

Note, that Applicants are involved and directed to "client authentication" in a Kerberos Realm using an asynchronous data exchange between a client (clients) and a series of servers.

The differentiation between Seitz and Applicants' system is that applications in Seitz are run in "an application environment on a server".

Applicants' system focuses to the data handling between an application (applications) running in the application environment and involve a service provided at the "operating systems level" environment.

Seitz in no way speaks to message or data handling between the "application level environment", to the "server level environment". The server environment is a pass-thru for holding or sending on messages. Applicants' system speaks to the managing of data sent from a client (clients) to the server with a return of the proper authentication signal.

C3. The thrust of Applicants' system is not so much about asynchronous message handling, but rather involves the "authentication" of a client in a Kerberos Realm via an asynchronous data exchange protocol. Applicants' system provides a unique arrangement in that there is a client and an exchange -- there is an exchange from client to first server, to second server, as will be seen in Applicants' figs. 15, 16 and 17.

It should be noted that the Seitz relation is from "client to server to client", where the so-called "messages" in Seitz are directed from client to client via a message handler on a server.

C4. The Seitz reference may be designated as "generic message exchange". Quite differently, Applicants' system is a specific set of data streams (as defined in Kerberos) that are initiated by a client, that is to say, a specific client application, such as a terminal emulator that "speaks" a specific protocol.

This is unique to Kerberos, where data is sent to a server, that is to say, a Kerberos Server, which performs certain actions on that server related to user "authentication". This Kerberos Server, after performing various authentication routines and activities, then forwards data to a Unisys ClearPath Server with a specific server-level software, (also known as the Operating System Software) which then takes the data received and then either "authenticates or rejects" the client data. The generated data from the Unisys ClearPath Server is then passed back to the Kerberos Server and to the client for further action based on the type of response generated. Again, this data is passed via an asynchronous data-handling protocol. The various modules involved and the functional steps involved are shown in Applicants' Figs. 15, 16 and 17 in abbreviated form.

C5. Applicants' asynchronous data handling protocol is unique to that particular environment because of the aforementioned data/message path which involves client---server---server. Quite differently, the Seitz reference is merely client---server---client.

The big difference here must be stressed, since the servers in Applicants' system are not running

applications merely to handle this data exchange. The servers in Applicants' system provide services in the operational system environment.

It will be seen that Seitz claims a client--server--client message handling system, but in looking at the detail of the Seitz reference, the so-called "server" in Seitz is actually running an application in the "application environment" in order to process a message exchange between two client applications.

Referring to Seitz column 4, line 29 --- "The server application 110 maintains a list 120" Thus, Seitz is utilizing an application for message exchange, but quite differently, Applicants' system operates using a data exchange through a server service provided at the Operating System level and not at the application level.

C6. It should be noted that since Seitz is handling the message exchange using an application, while Applicants' system is using a server service for data exchange, then Applicants' method, will by its nature, be much more efficient and operate under an algorithm which is much more reliable.

Seitz' application on the server requires server services. But Applicants' method is providing the service without going through an additional "layer" of additional application. It is noted that the more layers involved, the less efficient

is the system, and the more layers involved there is a slower factor in the response time.

C7. Taking a more general look at the Seitz reference, it would appear that Seitz is speaking to the idea of a generic message handling in a traditional client/server network. Quite differently, Applicants' system and method has a specific protocol related to a Kerberos environment where data is passed from a client (terminal emulator) to a Kerberos Server (KDC) to a Unisys ClearPath Server.

Both Seitz and Applicants are also "handling" asynchronous messages, but they are being handled in a different environment. Seitz is handling generic messages, while Applicants are focused on authentication in a Kerberos Realm, which is one of the activities associated with the asynchronous data handling, but in quite a different environment from that of Seitz.

C8. Regarding the KNAS inferences cited by Examiner, Applicants are in no way attempting to claim the origination of the so-called authentication algorithms developed in the Rfc 1510 of KNAS.

On the other hand, Applicants' system and method uses a number of "services" supplied by Kerberos and/or within a Kerberos Domain.

What makes Applicants' system unique is that the Unisys ClearPath Server which is participating in the Kerberos Realm must also authenticate a client within its domain, and

these services reside on the Unisys ClearPath Server.

All participants within the Kerberos Realm follow a Kerberos authentication protocol. Applicants' system sets forth that type of authentication within the Kerberos Realm to operate between the Kerberos Server and the Unisys ClearPath Server, which is a one-to-one Server-to-Server protocol, which is a unique arrangement.

That the client application (Terminal Emulator) request or authentication, must first be authenticated by the Kerberos Server, and then in turn, handled by the Unisys ClearPath Server, is not considered or shown by the Rfc 1510 of KNAS.

There is no discussion in Rfc 1510, as to the data handling between participants in the Kerberos Realm and that is why Applicants' method of asynchronously handling of data between client to Kerberos Server, to Unisys ClearPath Server, is a unique arrangement. Neither Seitz nor Rfc 1510 speak to data handling in an asynchronous fashion from client--to server--to server, back to the client. The only aspect of Rfc 1510 (within the Kerberos Realm) is that which speaks only client to server to client, authentication. But note in Applicants' method, Applicant requires additional authentication by the Unisys ClearPath Server and has the associated asynchronous data handling to achieve said authentication.

D. Examiner has further rejected claims 4-6, 10 and 13-15 under 35 USC 103(a) obviousness as unpatentable over the Seitz reference, further in view of the Schanze U.S. Patent 6,003,136.

Contrary to Examiner's statement, the Seitz references does not teach the use of asynchronous authentication of multiple concurrent clients in a Kerberos environment to maximize network efficiency. Further, Seitz does not teach or show the implementation of Applicants' Master Control Program, General Security Service Library, or the Kerberos Support Library.

Examiner's reference that Schanze 6,003,136 teaches these things is not relevant and is inoperable for Examiner's consideration, since the Schanze patent 6,003,136 is commonly-owned by the same entity as is the current application. The cited prior Schanze reference indicates the Assignment shows common ownership to the Unisys Corporation as per Assignment date of September 19, 1997 at Reel/Frame 8663/0638.

As stated in the Manual of Patent Examination Procedure, section 706.02(1)(1), it has been indicated that:

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter.

(c) Subject matter developed by another person, which qualifies as prior art only under one or more subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section

where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

In regard to 35 USC 102(a) and 102(e), it is not permissible for the Examiner to cite against a patent application another reference which is commonly-owned by the same entity.

The fact that Schanze patent 6,003,136 suggests that the overhead associated with Kerberos systems may be obviated through the use of programs that allow continued processing of requests --- does not operate to such a reference against the current application, since this type of reference is not permissible under the conditions of common ownership.

E. Examiner, at page 6 of his Office Action, paragraph 2, has stated as to claims 4-6, 10 and 13-15 of Applicants' claims, that there are a number of items designated "a", "b", "c", . . . "o", "p", "q", "r", which Examiner has selected from bits and pieces of the Seitz reference and from the document on Kerberos Network Authentication Service, and from the mentioned earlier reference of Schanze 6,003,136.

Here again, we see that the Examiner has been taking bits and pieces from various reference

elements and then trying to patch them together to re-create Applicants' invention.

Here, Applicants would cite the case of Appeal No. 2001-1102 in the United States Patent & Trademark Office, Board of Patent Appeals and Interferences, which was decided on January 16, 2002, where the Board had stated as follows, as indicated at 63 USPQ 2d, p. 1196:

Patent Examiner's rejection of Applicants' claims on grounds of anticipation and obviousness over prior art reference are vacated, since Examiner has made no cogent attempt to read reference into independent claim in application, and therefore has not established that he determined that all limitations of Applicants' claims are explicitly or inherently described by prior art and since Examiner's finding that independent claim is "generically" described by reference is insufficient for obviousness rejection; Examiner's rejection for anticipation based on second prior art reference is reversed, since that reference does not disclose specific combination of components set out in Applicants' independent claim. Further, Applicants would reiterate the previous reference to the case of Price v. Code Alarm, Inc., decided November 5, 1992 by the U.S. District Court of the Northern District of Illinois, where it was indicated:

That combination claims are not invalid for obviousness merely because similar elements appear in separate prior art references. The Court stated that one may not pick and choose among the individual elements of prior art references in order to re-create the basis of the invention. . . . Not only must the claim combination be considered as a whole under the express mandate of USC 103, but the prior art references must also be considered in their entireties to determine whether they suggest the desirability of making the combination (underlines added).

There is no combination of information in the Seitz reference or in the Kerberos Network Authentication Service document which can teach the functionality and the architecture of Applicants' Figs. 15, 16 and 17, which, as was previously stated, involve an operating level relationship between the Client 10, the ClearPath Server 13 and the Kerberos Server 20, which operate on an asynchronous basis to pass authentication data back to the client or clients requesting it.

Again note, that Applicants' system and method involve an asynchronous data exchange from client to ClearPath Server to Kerberos Server, which is completely different than the Seitz operation from client to server back to client.

Applicants' system is providing this service without going through an additional "layer" of application, where it should be noted that the more layers involved, the less efficient

is the system and the more layers involved develop a slower response.

Again, it should be reiterated that the concern and focus of Applicants' system is that of "authentication" done with specific modules involving a ClearPath Server and a Kerberos Server which is not taught by, or implemented in any way by the cited reference or the KNAS documents.

As will be noted in Fig. 1 of Seitz, the Server computer 102 operates to interchange messages between client computer 104 having client applications 106 and other client computers 104 having client applications 106. Also, the fact that Seitz mentions a Kerberos environment at column 19, line 33 et seq., does not teach the functionality and architecture of Applicants' system.

Further, the fact that Seitz, at column 19 lines 23, et seq. which briefly discusses authentication, does not show or teach or implement any system for authentication as is shown by Applicants' Figs. 15, 16 and 17.

Other elements cited by Examiner from the prior Schanze reference 6,003,136 are not operative or allowable as a reference under the doctrine of 102(e), as previously stated.

Amendments have been made to the claims in order to correct those possible deficiencies previously mentioned by the Examiner. Now, with the extant claims shown to be a combination of elements which must be considered as a whole in their entirety, it is now respectfully requested that Examiner look at the claims as a whole in their entirety as an overall functioning system, which

in no way can be recreated or redesigned from the combination of elements cited by the Examiner.

In this regard it is now respectfully requested that Examiner understand the implications of these patent laws and subsequently provide a timely Notice of Allowance for the extant claims.

Respectfully submitted,

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Date:

February 4, 2004

Patti S. Freddy

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